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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,812	03/26/2004	Gary S. Ambrosino	Cognio112US	2811

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EXAMINER

TORRES, MARCOS L

ART UNIT	PAPER NUMBER
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2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/708,812

Applicant(s)

AMBROSINO, GARY S.

Examiner

Marcos L. Torres

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5-28-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) filed on 5-28-04 was considered by the examiner.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 40 and 41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The instructions encoded in a processor readable medium do not produce any tangible result. Therefore, the claimed invention is directed to non-statutory subject matter

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 7-10, 14-15, 17-22, 24-25, 27-28, 30-32, 35-37 and 39-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Sharony US007019663B2.

As to claim 1, Sharony discloses a method for determining the physical location of a device that has both wireless wide area network (WAN) communication capability

and wireless local area network (LAN) communication capability (see col. 1, lines 43-50), the method comprising steps of: receiving a signal at the device from wireless WAN equipment that causes the device to initiate a wireless LAN location process (see fig. 2b, item 305); and executing the wireless LAN location process to determine the physical location of the device (see fig. 2b, item 306-314).

As to claim 2, Sharony discloses a method wherein the step of receiving comprises receiving a signal paging signal (see col. 2, 46-60).

As to claim 3, Sharony discloses a method of claim 1, and further comprising the step of receiving a location request that includes an identifier of the device to be located (see col. 2, 46-60).

As to claim 4, Sharony discloses a method in response to receiving the location request, further comprising the step of sending a signal to the wireless WAN equipment that requests the wireless WAN equipment to transmit the signal that causes the device to initiate the wireless LAN location process (see col. 2, 46-60).

As to claim 7, Sharony discloses a method wherein the step of executing the wireless LAN location process comprises executing a process that computes the location of the device based on one or more of: time of arrival data, time difference of arrival data, and received signal strength data, derived from a signal transmitted by the device (see col. 3, lines 29-60).

As to claim 8, Sharony discloses a method further comprising the step of executing a software application (instructions) in the device that initiates the wireless LAN location process (see col. 2, lines 47-50).

As to claim 9, Sharony discloses a method further comprising, at a computing device coupled to the wireless LAN, generating at least one signal to be transmitted by a wireless LAN device to the device and one or more other wireless LAN devices in order to set-up the wireless LAN location process (see col. 3, lines 7-18).

As to claim 10, Sharony discloses a method of claim further comprising, at the computing device, the step of processing data derived from one or more signals transmitted by the device to be located to determine the physical location of the device (see col. 3, lines 19-28; col. 2, lines 35-37).

As to claim 14, Sharony discloses a method further comprising the step of downloading to the device a software application that the device uses to initiate the wireless LAN location process in response to receiving the signal from the wireless WAN equipment (see col. 2, lines 47-50).

As to claim 15, Sharony discloses a method further comprising the step of sending location information of the device to a party (see fig. 2b, item 314).

As to claim 17, Sharony discloses a method wherein the step of sending comprises sending location information of the device to a party that requested location of the device (see fig. 2b, item 314).

As to claim 18, Sharony discloses a method of claim wherein the wireless WAN equipment transmits the signal to the device in response to receiving a request for location of the device by the party (see fig. 2b, item 300-314).

As to claim 24, Sharony discloses a method further comprising the step of initiating a wireless LAN connection if the device is not already connected to the

wireless LAN when it receives the signal from the wireless WAN equipment (see col. 3, lines 1-28).

As to claim 25, Sharony discloses a method further comprising the step of sending a message that is processed by the wireless WAN equipment, which in response, transmits the signal to the device that causes the device to initiate the wireless LAN location process (see fig. 2a 2b, item 300).

As to claim 27, Sharony discloses a method for determining the physical location of a device that has both wireless wide area network (WAN) communication capability and wireless local area network (LAN) communication capability (see col. 1, lines 43-50), the method comprising steps of: a. transmitting a wireless signal from the device, wherein the wireless signal includes information that indicates a location procedure is to be performed with respect to the device (see col. 2, lines 61-67); and executing a wireless LAN location process to determine the physical location of the device (see fig. 2b, item 306-314).

As to claim 28, Sharony discloses a method wherein the step of transmitting comprises transmitting a wireless LAN signal (see col. 3, line 2 – col. 4, line 3).

As to claim 30, Sharony discloses a method further comprising the step of receiving the wireless signal from the device, at a computing device, transmitting a signal to the wireless device to set-up the wireless LAN location procedure (see fig. 2a 2b, item 300,303).

As to claim 31, Sharony discloses a method of claim 30, wherein the step of executing comprises computing the location of the device based on data derived from at

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least one signal transmitted by the device and received at one or more other wireless LAN devices (see fig. 2a 2b, item 314).

As to claim 32, Sharony discloses the method wherein the step of transmitting comprises transmitting a wireless WAN signal (see fig. 2a 2b, item 303).

As to claim 35, Sharony discloses the method further comprising the step of receiving the signal at wireless WAN equipment, and in response thereto, transmitting a signal to the device that causes the device to initiate the wireless LAN location (see fig. 2a 2b; item 300, 303).

Regarding claims 19-22 and 39-41 they are rejected for the same reasons of claims 1, 8-9 shown above.

As to claims 36 and 37, they are the corresponding device claims of method claims 1 and 9. Therefore, claims 36 and 37 are rejected for the same reasons.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claims 5-6, 11-13, 16, 23, 26, 29, 33-34 and 38 rejected under 35 U.S.C. 103(a) as being unpatentable over Sharony in view of Fomukong US006560461B1.

As to claim 38, Sharony discloses a method for managing a process for locating a device that has both wireless wide area network (WAN) communication capability and wireless local area network (LAN) communication capability (see col. 1, lines 43-50), the method comprising steps of: receiving from a party a request to locate the device (see fig. 2a 2b, item 300); sending a signal to wireless WAN equipment that caused the wireless WAN equipment to transmit a signal to the device the causes the device to initiate a wireless LAN location process (see col. 2, 46-60); and receiving location information determined from the wireless LAN location process; and delivering the location information to the party (see fig. 2b, item 314). Sharony do not specifically disclose verifying the party making the request and the device to be located. In an analogous art, Fomukong discloses verifying the party making the request and the device to be located (see col. 2, lines 1-13). Therefore it would have been obvious to one of the ordinary skill in the art at the time of the invention to verify the data for the simple purpose of disclose only authorized information.

As to claim 34, Fomukong discloses the method wherein the step of transmitting comprises transmitting a message that includes an identifier of a party or destination to receive location information about the device (see col. 2, lines 1-13).

As to claim 5, Fomukong discloses the method wherein the step of receiving the location request comprises receiving a signal including pager number (see col. 3, lines 18-56).

As to claim 6, Fomukong discloses the method further comprising the step of verifying at least one of the identifier of the device and the party requesting the location of the device (see col. 2, lines 1-13).

As to claim 16, Fomukong discloses the method wherein the step of sending comprises sending the location information in the form of paging message and an identifier of the party is designated by a user of the device (see col. 3, lines 18-56).

As to claims 26 and 33, Fomukong discloses the method wherein the step of placing the call comprises placing an emergency call (see col. 4, lines 62-64).

As to claim 12, Fomukong discloses the method further comprising the step of receiving at the wireless WAN equipment an emergency call from the device (see col. 4, lines 62-64). Sharony discloses transmitting the signal to the device that causes the device to initiate the wireless LAN location process (see fig. 2b, item 303).

As to claim 13 the method further comprising the step of sending information describing the physical location of the device to an emergency responder facility is a requirement set by the FCC. Therefore, it is not an inventive step.

As to claims 11 and 23, Sharony and Fomukong discloses everything as disclosed above except for the method further comprising the step of terminating a wireless LAN connection at the device after completion of the wireless LAN location process. However OFFICIAL NOTICE IS TAKEN THAT the method of terminating a

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connection after being used is common and well-known technique used to prevent wasting the bandwidth. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to terminate the connection for the simple purpose of saving bandwidth.

As to claim 29, Sharony and Fomukong discloses everything as disclosed above except for the method wherein the step of transmitting comprises placing a voice-over-IP call. However, OFFICIAL NOTICE IS TAKEN THAT the method wherein the step of transmitting comprises placing a voice-over-IP call is a common and well-known technique used globally. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use VOIP for the simple purpose of compatibility with the Internet.

Conclusion

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Hand delivered responses should be brought to:

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Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcos L. Torres whose telephone number is 571-272-7926. The examiner can normally be reached on 8:00am-6:00 PM alt. Wednesday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-252-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marcos L Torres
Examiner
Art Unit 2617


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GEORGE ENG
SUPERVISORY PATENT EXAMINER